

REMARKS

The Office has required restriction in the present application as follows:

- Group I: Claims 61-71, drawn to an implant comprising a biocompatible support and eukaryotic cells anchored onto the surface of the support;
- Group II: Claims 72-82, drawn to a method for administering cells to a mammalian host by anchoring eukaryotic cells to a biocompatible support to make an implant, and introducing the implant into a mammalian host; and
- Group III: Claims 83-91, drawn to a method for treating a mammalian host effected with a disease by administering an implant to said host.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. M.P.E.P. § 803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Office states that the invention of Group I is "patentably distinct from the invention of Group II because they are drawn to a composition and method that are not related directly." Further, the Office states "The method of Group II can also be accomplished by direct injection of cells to the mammalian host." However, the proposed "direct injection of cells" method cannot logically be accomplished by the method of Group II, because, for example, Claim 72 requires that the eukaryotic cells be administered to a mammalian host by introducing an *implant*, not direct injection of cells, into the mammalian

host. Thus, the Examiner's argument in support of restriction is factually incorrect, and therefore restriction is improper.

The Examiner has characterized the inventions of Groups I and III as related as product-and-process of use. The Office states that "A method for treating a disease can be accomplished by administering a pharmaceutical compound directly to the host", and that the "Implant of Group I can also be used to deliver a medication." However, there is no evidence of record to show that the implant of Group I can be used as alleged by the Office, or that the disease of Group III can be treated with a pharmaceutical compound. Furthermore, even if the claimed product can be used as alleged, or the claimed method could be carried out with a different product as alleged, the Office has failed to show that the alleged use or alleged product are materially different from what is claimed. Accordingly, the requirement for restriction is improper, and it should be withdrawn.

Furthermore, the Office simply concludes that the inventions of Groups II and III are "patentably distinct" without providing any reasons, whatsoever, in support thereof. Accordingly, Applicants respectfully submit that the requirement for restriction is improper, and request that it be withdrawn.

Applicants note that M.P.E.P. § 821.04 states: "If applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." Applicants respectfully submit that Claims 72-82 do, in fact, "otherwise include all the limitations" of the product claims. Applicants therefore respectfully submit that should the elected group be found allowable, the non-elected claims should be rejoined.

Finally, M.P.E.P. § 803 states:

"If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the

merits, even though it includes claims to distinct or independent inventions.”

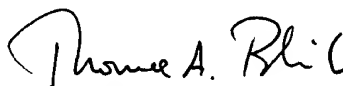
Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



---

Norman F. Oblon  
Attorney of Record  
Registration No. 24,618

Thomas A. Blinka, Ph.D.  
Registration No. 44,541

22850

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
NFO/TAB/cja